



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,530	06/04/2001	Takechito Utsunomiya	B422-159	3562

26272 7590 03/20/2006

COWAN LIEBOWITZ & LATMAN P.C.
JOHN J TORRENTE
1133 AVE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,530

Applicant(s)

UTSUNOMIYA, TAKEHITO

Examiner

Nga B. Nguyen

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication filed on June 4, 2001, which paper has been placed of record in the file.
2. Claims 1-29 are pending in this application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 12 is rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

As to claim 12, the claimed invention is implemented as ***Functional Descriptive Material Per Se***. "A computer program" is considered as functional descriptive material, and "a computer program" recited in the claim is not recorded on some computer-readable medium. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer

Art Unit: 3628

readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory

Therefore, the claim is non-statutory, because it is directed solely to Functional Descriptive Material *Per Se*.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-17 and 19-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson, U.S. Patent No. 6,535,726.

Regarding to claim 1, Johnson discloses a service presenting apparatus for presenting predetermined service in accordance with an operation of the user, comprising:

input means for inputting access information of a portable terminal (figure 1A and column 4, lines 25-35, the POS 110 includes a local communications interface 184 adapted for localized communication with the cellular telephone 140);

access means for effecting terminal in accordance with the access to said portable access information inputted by said input means (column 5, lines 40-50, the IKD 130 is adapted to recognize whether a given cellular telephone 140 is associated with an approved supporting cellular network 160);

receiving means for receiving predetermined information from said portable terminal by effecting the access to the user's portable terminal via said access means (column 5, lines 50-55, the IKD 130 transmits a message containing notice to the cellular phone 140 for displaying to the customer, the IKD would prompt the customer to utilize alternate payment means); and

processing means for effecting predetermined processing in accordance with the predetermined information (column 6, lines 5-12, if the transaction is not authorized, the IKD 130 transfers an appropriate message to the cellular telephone 140 for displaying to the customer).

Regarding to claim 2, Johnson further discloses wherein said predetermined service is input/output of an image (column 5, lines 50-55).

Regarding to claim 3, Johnson further discloses wherein said predetermined processing is charge processing (column 6, lines 12-23).

Regarding to claim 4. Johnson further discloses wherein said predetermined information is authentication regarding payment for the predetermined service (column 6, lines 3-23).

Regarding to claim 5, Johnson further discloses wherein the authentication regarding payment for the predetermined service is authentication regarding deduction

of payment for said predetermined service from user's account of a banking organ to which he contracts regarding his portable terminal (column 6, lines 17-23).

Claims 6-10 are written in method claims that contain similar limitations found in claims 1-5 above, therefore, are rejected by the same rationale.

Claims 11-12 are written in computer medium and computer program and contain similar limitations found in claim 1 above, therefore, are rejected by the same rationale.

Regarding to claim 13, Johnson discloses a network system in which a server computer and a terminal is interconnected via a network and which is designed to present predetermined service in accordance with an operation of the user (figure 1A and column 5, lines 5-15, the supporting cellular network 160 and POS 110 interconnected via cellular link or standard telephone lines, or network links), comprising:

charge processing means for effecting processing for deducting the charge from user's account of a banking organ to which he contracts regarding his portable terminal (column 6, lines 12-23, if the transaction is authorized, the IKD 130 receives transaction total information from the POS 110 and transfers to the supporting cellular network 160, the supporting cellular network 160 then processes the transaction charges against the customer account associated with the cellular telephone 140).

Regarding to claim 14, Johnson further discloses wherein said charge processing means effects.

Art Unit: 3628

processing for requesting input of access information to the user's portable terminal via said terminal (figure 1A and column 4, lines 25-35, the POS 110 includes a local communications interface 184 adapted for localized communication with the cellular telephone 140);

processing for effecting access to said user's portable terminal via in accordance with the access information (column 5, lines 40-50, the IKD 130 is adapted to recognize whether a given cellular telephone 140 is associated with an approved supporting cellular network 160); and

processing for deduction of charge effecting authentication regarding from user's account of a banking organ to which he contracts regarding his portable terminal, by effecting the access to said user's portable terminal (column 6, lines 17-23, the supporting cellular network 160 then processes the transaction charges against the customer account associated with the cellular telephone 140.

Regarding to claim 15, Johnson further discloses wherein a terminal of a contract company to which he contracts regarding his portable terminal is connected to said network, and further comprising notifying means for notifying the authentication to said terminal of the contract company (column 6, lines 12-23, if the transaction is authorized, the IKD 130 receives transaction total information from the POS 110 and transfers to the supporting cellular network 160).

Regarding to claim 16, Johnson further discloses wherein said portable terminal is a cellular phone (figure 1A, the cellular phone 140).

Regarding to claim 17, Johnson further discloses wherein said predetermined service is information presenting service for acquiring information from said server computer (column 4, lines 55-column 5, line 5).

Regarding to claim 19, Johnson further discloses wherein the network system is connected to an external device via said network, and said charge processing means receives. from said external device, the authentication regarding deduction of charge from user's account of the banking organ to which he contracts regarding his portable terminal effected by said external device (column 5, lines 15-27, an outside billing network 196).

Regarding to claim 20, Johnson further discloses wherein selection can be made between a system in which the charge is deducted from the user's account of the banking organ to which he contracts regarding his portable terminal and other system (column 6, lines 3-23).

Claims 21-25 contain similar limitations found in claims 13, 14, 16, 17, 20 above, therefore, are rejected by the same rationale.

Claims 26-29 contain similar limitations found in claim 13 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3628

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, U.S. Patent No. 6,535,726.

Regarding to claim 18, Johnson does not disclose wherein said terminal has print means for printing out the information acquired from said server computer. However, it is well known in the art that the terminal has print means for printing out the information acquired from said server computer. For example, POS terminal contains a printer for printing receipts for customers. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Johnson to include a print means in Johnson POS terminal, for the purpose of providing transaction information to customers.

Conclusion

9. Claims **1-29** are rejected.
10. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Rudisill (US 6,816,721) discloses system and method for enabling the purchase of products and services using a prepaid account associated with a wireless telephone.

Griffith (US 6,195,542) discloses a method for utilizing a wireless telephone to function as a transaction device in conjunction with central computer that establishes the validity of the wireless telephone to make transactions.

Art Unit: 3628

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).

March 1, 2006



NGA NGUYEN
PRIMARY EXAMINER